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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,190	08/31/2001	Daniel M. Wing	1242.017	1208

7590

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EXAMINER

DESANTO, MATTHEW F

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,190

Applicant(s)

WING ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 78 and 80-93 is/are pending in the application.
- 4a) Of the above claim(s) 88 and 89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 78, 80-87, 90-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3763

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 88, 89 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to a non-elected species.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 88, 89 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

2. The claim objection to claim 31 is withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 78, 80-87 and 90-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riza et al. (USPN 5,993,471) and further in view of Shipp (USPN 5,263,937).

Riza et al. discloses trocar assembly with a cannula and an obturator and a first (19) and second (16A) bearing surface. Wherein the first and second bearing surface slidably engage each other when rotating the obturator relative to the cannula as well as wherein the first or second bearing comprises an incline, and/or a boss and/or a linear and curvilinear surface, and wherein the first bearing surface is moveable relative to the cannula and the second bearing surface is moveable relative to the obturator, and wherein the head assembly has a bearing surface, a fluid port with a valve (See Figures 2, 3, 4 and entire reference); but fail to claim a radially expandable opening formed in the distal end of the cannula.

Shipp discloses an obturator, and a cannula, wherein the cannula has a radially expandable opening that is flexible, smooth and continuous (Figure 1, 3, 4, 7 and abstract and entire reference).

At the time of the invention it would have been obvious to one of ordinary skill in the art to combine the trocar of Riza et al. with the teachings of Shipp because Shipp discloses an opening at the distal end of the cannula, wherein the opening has the ability to radially expandable, which serves as a benefit so that the force need to cause the trocar to penetrate the abdominal wall will be reduced (abstract - Shipp).

Response to Arguments

5. Applicant's arguments, filed on 10/29/04, with respect to all the prior art of record were fully considered and were persuasive. The 102 Rejections in view of Cox et al., Smith et al., Riza et al. and Shipp et al. have been withdrawn.

6. With regards to Riza et al., the examiner disagrees with the interpretation of Riza et al. According to MPEP section 2114 there must be structurally different elements in an apparatus claim in order to receive a patent. Riza et al. has the same structure as the claimed invention when combined with Shipp and therefore the 103 Rejection was given and the claims were not allowed.

7. With regards to the intended use of elements 16a and 19 being used as a lock and not being capable of sliding engage and cause axial displacement, the examiner disagrees. In order to separate or combine elements 16a and 19, there must be some interaction between those elements thus forcing the axial displacement to occur when the elements are going to be separated if locked together or when the elements are separated and will be locked together. Since the language is functional language and the language is in an apparatus claim the prior only has to be capable of performing the function, and therefore, examiner has determined that the prior art is capable of performing the functions claimed, thus the 103 Rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 3763

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto
Art Unit 3763
January 5, 2005



NICHOLAS D. LUCCHESI
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